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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/594,955	06/15/2000	Ralph F. Conley JR.	DBT-002	9875

7590

07/28/2005

Steven J Rosen
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Cincinnati, OH 45241

EXAMINER

BLAIR, DOUGLAS B

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/594,955

Applicant(s)

CONLEY, RALPH F.

Examiner

Douglas B. Blair

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "banner display means having a menu display means for presenting a menu of navigation options when an end-user clicks on said banner" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed software must be embodied on some form of computer readable medium.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-29, 31-34, 36-37, and 40-53 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,141,010 to Hoyle in view of U.S. Patent Number 6,587,118 to Yoneda in further view of U.S. Patent Number 6,642,946 to Janes et al..

7. Hoyle teaches the invention as claimed (as in exemplary claim 49) including a banner display publishing system comprising: a publishing server connected to the network, publishing software operably running on said server said publishing software operable for producing and

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changing banner software that is used to display banners (col. 9, line 27-col. 5, line 18), said publishing software comprising: a means for selecting navigation options for the banner software, wherein the banner software is in machine readable format having a banner display means for displaying a banner on a screen on an end-user computer, said banner display means having a menu display means for presenting navigation options when an end-user clicks on said banner (col. 9, line 27-col. 5, line 18), and the navigation options being a URL on said network to which said end-user computer is connectable (col. 9, line 27-col. 5, line 18); and a means for storing said banner software on said server, and a means for distributing said banner software to said end-user computer (col. 13, line 44-col. 14, line 5).; however Hoyle does not explicitly teach a menu of navigation options when an end-user clicks on said banner.

8. Yoneda teaches a menu display means for presenting a menu of navigation options when an end-user clicks on a graphic (Figures 3A and 3B and col. 7, lines 31-50).

9. It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Hoyle regarding banner publishing software with the teachings of Yoneda regarding the presentation of a menu of multiple navigation options when an end user clicks on a graphic because a publisher could want a banner to reflect multiple options for navigating information based on geographic preferences as in the Janes reference (Figure 2A and col.4, line 48-col. 5, line 14).

10. As to claims 1, 28, 36, 40, and 41, they feature the same limitations as claim 49 and are rejected for the same reason as claim 49.

11. As to claims 2, 11, 17, 25, and 42, Hoyle teaches a means for monitoring end-user's behavior regarding accessing said banner, a means for maintaining a local event statistics

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database of said end-user's behavior regarding accessing said banner, and a means for transmitting information in said local event statistics database to a server computer on said network (col. 7, lines 6-13).

12. As to claims 3, 12, 18, 26, and 43, Hoyle teaches a local event statistics database including the number of times a banner was accessed by an end-user (col. 11, line 50- col. 12, line 26).

13. As to claims 4, 13, 19, 27, and 44, Hoyle teaches a local event statistics database further including URLs on a network to which end-user computer has been directed through a choice from navigation options (col. 11, line 50- col. 12, line 26).

14. As to claims 5 and 20, Hoyle teaches the use of nested menus in a menu of navigation options (Figure 5A).

15. As to claim 6, Hoyle teaches the use of cascading menus in a menu of navigation options (Figure 5A).

16. As to claim 7, 14, 21, 29 and 45, Hoyle teaches options including one or more addresses to files stored on fixed storage means for fixedly storing files on the end-user computer (col. 10, lines 35-51).

17. As to claims 8, 15, 22, and 46, Hoyle teaches the use of a hard drive and CD-ROM drive (col. 7, lines 14-26).

18. As to claims 9, 23, 47, and 50, Hoyle teaches a means for detecting a network connection and executing a transaction with a network server to determine if at least one of said banner and said navigation options should be updated (col. 11, line 50-col. 12, line 26).

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19. As to claims 10, 48, and 51, Hoyle teaches a means for updating a banner and a navigation option (col. 11, line 50-col. 12, line 26).
20. As to claim 16, Hoyle teaches a banner updating means for allowing a publisher to change said navigation options (col. 11, line 50-col. 12, line 26).
21. As to claim 31, Hoyle teaches a means for selecting a banner image file for the banner display means to display as the banner (col. 14, line 46-col. 15, line 28).
22. As to claim 32, Hoyle an installation means for installing the banner software in an application (col. 13, line 44-col. 14, line 5).
23. As to claim 33, Hoyle teaches a means for updating banner software in an application (col. 13, line 44-col. 14, line 5).
24. As to claim 37, Hoyle teaches an alerting means for alerting the end-user that the message has been sent to the end-user computer (col. 11, line 50-col. 12, line 26, displaying a banner is considered alerting the user of a message).
25. As to claim 52, Hoyle teaches messaging software operable on a server computer for producing and sending a message that appears on the screen of end-user computers having banner software installed and a means for displaying said message when said banner is displayed on a screen on an end-user computer (col. 13, line 44-col. 14, line 5).
26. As to claim 34 and 53, Hoyle teaches an alerting means for alerting the end-user that the banner software has been changed on the end-user computer (col. 16, lines 24-52).
27. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,141,010 to Hoyle in view of U.S. Patent Number 6,587,118 to Yoneda in further view

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of U.S. Patent Number 6,642,946 to Janes et al. in further view of U.S. Patent Number 6,678,663 to Mayo.

28. As to claim 30, the Hoyle-Yoneda-Janes combination does not explicitly teach linking an email address as an option.

Mayo teaches the option of linking an email address of an advertiser (col. 7, line 43-col. 8, line 12)

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of the Hoyle-Yoneda-Janes combination regarding displaying navigation options with the teachings of Mayo regarding the linking of email addresses because email provides a way to contact an advertiser (Mayo, col. 7, line 43-col. 8, line 12).

29. Claims 35, 38-39 and 54-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,141,010 to Hoyle in view of U.S. Patent Number 6,587,118 to Yoneda in further view of U.S. Patent Number 6,642,946 to Janes et al. in further view of U.S. Patent Number 5,666,500 to Roberson.

30. As to claims 35, 38, and 54, Hoyle teaches alerting a user that a banner has changed and the use of icons; however the Hoyle-Yoneda-Janes combination combination does not explicitly teach an icon changing appearance to alert an end-user.

Roberson teaches an alerting means altering the appearance of an icon on a screen of the end-user computer (col. 4, lines 54-55).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of the Hoyle-Yoneda-Janes combination

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regarding displaying navigation options with the teachings of Roberson regarding the altering the appearance of an icon because altering the appearance of an icon attracts a user's attention (Roberson, col. 4, lines 54-55).

31. As to claims 39 and 55, the icon taught by Roberson can be considered a button because when clicked on it launches software.

Response to Arguments

32. Applicant's arguments with respect to claims 1-55 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B. Blair whose telephone number is 571-272-3893. The examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Douglas Blair



ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER